



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/895,894	06/29/2001	Manoel Tenorio	020431.0848	7075
7590 03/10/2004				
Christopher W. Kennerly Baker Botts L.L.P. 2001 Ross Avenue, Suite 600 Dallas, TX 75201-2980		EXAMINER CHEUNG, MARY DA ZHI WANG		
		ART UNIT 3621		
		PAPER NUMBER		

DATE MAILED: 03/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/895,894

Applicant(s)

TENORIO, MANOEL

Examiner

Mary Cheung

Art Unit

3621



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Claims

1. This action is in response to the application filed on June 29, 2001. Claims 1-34 are pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding independent claims 1, 11, 21 and 31-34, the phrase "not substantially affecting" renders the claim indefinite because it is unclear how exactly the authorized use of data are not being affected.

The dependent claims 2-10, 12-20 and 22-30 are rejected for incorporating the errors of their respective base claims by dependency.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3621

5. Claims 1-5, 8, 11-15, 18, 21-25, 28 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogilvie, U. S. Patent 6,343,738, U. S. Patent 6,343,738 in view of Walker et al, U. S. Patent 6,249,772.

As to claims 1, 11, 21 and 31, Ogilvie teaches a system, a method and software for watermarking data associated with one or more products, comprising (column 18 lines 55-56 and column 19 lines 55-56 and column 20 lines 53-56 and Figs. 9-10; *specifically, "one or more products" corresponds to the digital goods, and "data" corresponds to the sample in Ogilvie's teaching*):

- a) Generate an algorithm for creating a particular pattern in data associated with one or more products available from one or more sellers (column 13 lines 45-46 and column 20 lines 8-23 and column 21 line 45 – column 22 line 9 and Fig. 6; *specifically, deleting every Nth character in Ogilvie's teaching is an example of "a particular pattern"*), the data being stored in one or more databases accessible to one or more buyer computers (Figs. 11-12), the pattern facilitating identification of a copy of the data and not substantially affecting authorized use of the data by the one or more buyer computers or users associated with the buyers computers (column 20 line 65 – column 21 line 40);
- b) Apply the algorithm to the data to create the particular pattern in the data (column 20 lines 8-23 and column 21 line 45 – column 22 line 9).

Ogilvie does not explicitly teach the data being stored in one or more databases accessible to one or more buyer computers for search queries for data associated with certain of the products. However, Walker teaches buyers search queries among

Art Unit: 3621

databases for data associated with certain of the products (column 9 line 57 – column 10 line 10 and Figs. 1-2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the data stored in one or more databases in Ogilvie's teaching to be searched as taught by Walker because this would allow buyers quickly and easily search desired information.

As to claims 2, 12 and 22, Ogilvie teaches data are stored in one or more databases as discussed above. Ogilvie does not explicitly teach the one or more databases comprise seller databases associated with a particular seller. However, Walker teaches this matter (Figs. 2-3, 5-6B). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the one or more databases in Ogilvie's teaching to include seller databases associated with a particular seller as taught by Walker because this would allow the broker to easily and accurately monitoring transactions.

As to claims 3, 13 and 23, Ogilvie teaches data are stored in one or more databases as discussed above. Ogilvie does not explicitly teach the one or more databases comprise a shared data repository. However, Walker teaches this matter (Figs. 2-3). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the one or more databases in Ogilvie's teaching to include a shared data repository as taught by Walker because this would allow the broker to easily collecting and organizing both buyers information and sellers information.

As to claims 4, 14 and 24, Ogilvie teaches data associated with one or more products as discussed above. Ogilvie does not specifically teach the data comprises

Art Unit: 3621

one or more product attribute values, seller attribute values, and product descriptions for each of the one or more products. However, Walker teaches data associated with one or more products comprises one or more product attribute values (*i.e. model number in Fig. 6A*), seller attributes values (*i.e. seller's price in Fig. 6A*), and product descriptions (*i.e. item description in Fig. 6A*). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the data in Ogilvie's teaching to include product attribute values, seller attribute values, and product descriptions because this would allow the buyers to better determine if certain products meet their needs.

As to claims 5, 15 and 25, Ogilvie teaches the algorithm is a sifting function (column 20 lines 8-23 and column 21 line 45 – column 22 line 9; *specifically, deleting every Nth character in Ogilvie's teaching is an example of "a sifting function"*).

As to claims 8, 18 and 28, Ogilvie teaches the pattern comprises a plurality of insertion, deletion, or modifications of printable ASCII characters in data according to a predefined arrangement (column 20 lines 8-23 and column 21 line 45 – column 22 line 9)

6. Claims 6-7, 16-17 and 26-27 and 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogilvie, U. S. Patent 6,343,738, U. S. Patent 6,343,738 in view of Walker et al, U. S. Patent 6,249,772 in further view of Kuo et al., U. S. Patent 6,230,288.

As to claims 6-7, 16-17 and 26-27, Ogilvie modified by Walker further teaches the pattern comprises a plurality of ASCII characters inserted throughout the data

according to a predefined arrangement; and a particular set of ASCII characters appearing after each instance of a particular group of characters in the data (Ogilvie: column 20 lines 8-23 and column 21 line 45 – column 22 line 9). Ogilvie modified by Walker does not specifically teach the ASCII characters are non-printable. However, Kuo teaches inserting non-printable ASCII characters into a file (column 5 lines 5-25). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the ASCII characters in the teaching of Ogilvie modified by Walker to be non-printable ASCII characters because this would provide sellers more choices with additional various patterns that can be added to the data so that the sellers' products can be better protected.

As to claims 32-34, Ogilvie teaches a system, a method and software for watermarking data associated with one or more products, comprising (column 18 lines 55-56 and column 19 lines 55-56 and column 20 lines 53-56 and Figs. 9-10; *specifically, "one or more products" corresponds to the digital goods, and "data" corresponds to the sample in Ogilvie's teaching*):

c) Generate an algorithm for creating a particular pattern in data associated with one or more products available from one or more sellers (column 13 lines 45-46 and column 20 lines 8-23 and column 21 line 45 – column 22 line 9 and Fig. 6; *specifically, deleting every Nth character in Ogilvie's teaching is an example of "a particular pattern"*), the data being stored in one or more databases accessible to one or more buyer computers (Figs. 11-12), the pattern comprising a plurality of ASCII characters inserted throughout the data according to a pre-defined

arrangement (column 20 lines 8-23 and column 21 line 45 – column 22 line 9), the pattern facilitating identification of a copy of the data and not substantially affecting authorized use of the data by the one or more buyer computers or users associated with the buyers computers (column 20 line 65 – column 21 line 40);
d) Apply the algorithm to the data to create the particular pattern in the data (column 20 lines 8-23 and column 21 line 45 – column 22 line 9).

Ogilvie does not explicitly teach the data being stored in one or more databases accessible to one or more buyer computers for search queries for data associated with certain of the products. However, Walker teaches buyers search queries among databases for data associated with certain of the products (column 9 line 57 – column 10 line 10 and Figs. 1-2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the data stored in one or more databases in Ogilvie's teaching to be searched as taught by Walker because this would allow buyers quickly and easily search desired information.

Ogilvie does not specifically teach the data comprises one or more product attribute values, seller attribute values, and product descriptions for each of the one or more products. However, Walker teaches data associated with one or more products comprises one or more product attribute values (*i.e. model number in Fig. 6A*), seller attributes values (*i.e. seller's price in Fig. 6A*), and product descriptions (*i.e. item description in Fig. 6A*). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the data in Ogilvie's teaching to further include

Art Unit: 3621

product attribute values, seller attribute values, and product descriptions because this would allow the buyers to better determine if certain products meet their needs.

Ogilvie modified by Walker does not specifically teach the ASCII characters are non-printable. However, Kuo teaches inserting non-printable ASCII characters into a file (column 5 lines 5-25). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the ASCII characters in the teaching of Ogilvie modified by Walker to be non-printable ASCII characters because this would provide sellers more choices with additional various patterns that can be added to the data so that the sellers' products can be better protected.

7. Claims 9, 19 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogilvie, U. S. Patent 6,343,738, U. S. Patent 6,343,738 in view of Walker et al, U. S. Patent 6,249,772 in further view of Berkland et al., U. S. Patent 4,648,047.

As to claims 9, 19 and 29, Ogilvie modified by Walker teaches applying a particular pattern in the data as discussed above. Ogilvie modified by Walker does not specifically teach the pattern comprises each instance of a particular group of characters in the data being underscored throughout the data. However, Berkland teaches inserting underscore function into a file (column 10 lines 17-24). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the particular group of characters in the teaching of Ogilvie modified by Walker to be underscored throughout the data because this would provide sellers more choices with additional various patterns that can be added to the data so that the sellers' products can be better protected.

Art Unit: 3621

8. Claims 10, 20 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogilvie, U. S. Patent 6,343,738, U. S. Patent 6,343,738 in view of Walker et al, U. S. Patent 6,249,772 in further view of Astola et al., U. S. Patent 6,094,722.

As to claims 10, 20 and 30, Ogilvie modified by Walker further teaches using checksum technique for granting permission usages of the data (Ogilvie: column 20 lines 31-40). Ogilvie modified by Walker does not specifically teach determining a first sum of numerical values of bytes representing the data stored in the one or more databases for later comparison with a second sum of numerical values of bytes representing data from another source to determine whether the data from the other source is a copy of the data from the one or more databases. However, this matter is taught by Astola as determining whether a file is original by comparing the sum of numerical byte values of the file with the checksum of the original data (column 1 lines 45-54). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the teaching of Ogilvie modified by Walker to include the feature of determining whether a data is original by comparing the sum of numerical byte values of the data with the checksum of the original data because this would allow duplicated data to be quickly and easily detected so that the sellers' products can be better protected.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 3621

Adams (U. S. Patent 5,974,548) discloses providing media-independent security for a document may be programmed to create a document file having two or more components.

Rhoads et al. (U. S. Patent 6,332,031) discloses multiple digital watermarks, each of which has different characteristics, are embedded in a document.

Bloom et al. (U. S. Patent 6,332,194) discloses watermark insertion.

Itoh et al. (U. S. Patent 6,700,989) discloses inserting watermark information into a moving image.

Watanabe (EP 1 148 704 A2) discloses a secure electronic watermark inserter.

Art Unit: 3621

Inquire

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is (703)-305-0084. The examiner can normally be reached on Monday – Thursday from 8:00 AM to 5:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

The fax phone number for the organization where this application or proceedings is assigned are as follows:

(703) 872-9306 (Official Communications; including After Final

Communications labeled "BOX AF")

(703) 746-5619 (Draft Communications)

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, 7th Floor Receptionist.

Mary Cheung
Patent Examiner
Art Unit 3621
March 4, 2004

